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09/902,407	07/10/2001	Yasser alSafadi	US010319	8261
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EXAMINER BOVEJA, NAMRATA				
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3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/902,407

Applicant(s)

ALSAFADI ET AL.

Examiner

NAMRATA BOVEJA

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/10/01 and 01/11/02 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This office action is in response to the RCE communication filed on 07/07/2008.
2. Claim 15 has been cancelled by the Applicant. Claims 1-14 and 16-21 are presented for examination.
3. Amendments to claims 1, 14, and 17 have been entered and considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 14, and 17 are rejected under 35 U.S.C. 101, because, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method and system claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Specifically, the claims do not recite what is involved in generating the recommendations. For example, does generating mean to look up something in a

database, simply displaying the results, or does it involve some actual processing by a computer. Furthermore, claim 1 also does not recite receiving a user selection of pre-defined user-selectable limiting factors using a computer.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

5. *Claims 1, 14, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

*In reference to claims 1 and 14, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “user-selectable limiting factors” in claims 1 and 14 is used by the claims to mean “factors that are independent of the search criteria”, while the accepted meaning is a factor that is selectable by a user. The term is indefinite because the specification does not clearly redefine the term. In fact, page 4 of the specification recites examples of limiting factors*

but never discloses a specific definition of the term "limiting factor." Furthermore, on page 7 of the specification, it is stated that "limiting factors represent user-specified limits on various characteristics of the recommendation-generating process implemented in the recommender system." Therefore, using this definition provided in the Applicant's specification, a limiting factor is not necessarily independent of the search criteria, but is interpreted to be a factor with user-specified limits, since this definition was not specifically defined in the specification. Additionally, the term "input" in claims 1 and 14 is used by the claims to mean "input that is dependent on the search criteria," while the accepted meaning is to enter data into a computer for processing per Dictionary.com. The term is indefinite because the specification does not clearly redefine the term. In fact, page 3 of the specification recites input as being representative of an offer or other opportunity, and page 7 of the specification gives examples of how input may include information. Since no specific definition of input has been provided in the specification, an input is not necessarily dependent on the search criteria, and an input is interpreted to mean enter data into a computer for processing.

6. *In reference to claim 17, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). the term "input" in claim 17 is used by the claim to mean "input that is independent of the one or more pre-defined, user-*

selectable limiting factors," while the accepted meaning is to enter data into a computer for processing per Dictionary.com. The term is indefinite because the specification does not clearly redefine the term. In fact, page 3 of the specification recites input as being representative of an offer or other opportunity, and page 7 of the specification gives examples of how input may include information. Since no specific definition of input has been provided in the specification, an input is not necessarily dependent on the search criteria, and an input is interpreted to mean enter data into a computer for processing. Additionally, claim 17 recites the recommender system "operating on" a recommendation-generating process. The term "operating on" is indefinite, since it is unclear what the Applicant means by this limitation. Typically, a system is used to carry out a process, but it does not operate on a process. It is interpreted to mean that the system carries out or performs the process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Disclaimer:** *Claims 1, 14, and 17 were found to be deficient under U.S.C. 101 and U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.*

Claims 1-3, 5, 8-10, 12-14, 16, 17, 20, and 21 are rejected under 102(a) as being anticipated by the LexisNexis website printouts (see attached pages) (hereinafter

Lexis).

In reference to claim 1, the Lexis teaches a method for use in an information processing system for generating a recommendation at a processing device, the method comprising: pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics (i.e. per page 8 of the Applicant's specification, optimal or near optimal output is based on the user input of ASAP versus take your time factors, and per Lexis, optimal processing can be achieved by selecting specific databases) of a recommendation-generating process implemented in the recommender system (i.e. giving the user the option to select the following Jurisdictions such as Federal Legal U.S., Federal and State case law, state court cases, MO Supreme Court and Court of Appeals Cases, MT Supreme Court Cases etc. (i.e. different databases can be searched) (pages 15 and pages 1-3 of the newly scanned pages included with this OA); *receiving a user selection of the one or more pre-defined, user-selectable limiting factors to be used (pages 15 and pages 1-3 of the newly scanned pages included with this OA)*; receiving an input in the recommender system (i.e. receiving a citation, party names, keywords) (pages 5, 6, 9, 12-15, 22, and 23); processing the input in the recommender system, *based on the search criteria*, by the recommendation generating process (i.e. input has to be processed with a recommendation generating process to provide the results) in accordance with the *selected* one or more pre-defined, user-selectable limiting factors (i.e. applying the factors to the search input) (pages 7, 17, and 22); and generating an output recommendation *in accordance with the search criteria* based at least in part on the

processed input (i.e. presenting the user with the results) (pages 7, 8, 17, and 22), the output recommendation being generated in accordance with an optimal processing as limited by the pre-defined one or more user-selectable limiting factors (i.e. the user selected limiting factors are used to produce optimally processed results where the user is given the option to select the following Jurisdictions such as Federal Legal U.S., Federal and State case law, state court cases, MO Supreme Court and Court of Appeals Cases, MT Supreme Court Cases etc. (i.e. different databases can be searched) (pages 15 and pages 1-3 of the newly scanned pages included with this OA).

8. In reference to claim 14, Lexis teaches an apparatus for use in generating a recommendation *based on search criteria* in a processing device information processing system, the apparatus comprising: memory for storing profile associated with the device (i.e. it is inherent that there is a memory for storing the profile, since the user is being asked to login using a login id which the user had to create previously during registration and which is currently stored in the system along with information such as student access versus professor access and e-mail information) (page 1); and a processor coupled to the memory, the processor being operative to process an input and one or more limiting factors in an implementation of a recommender system (pages 5, 6, 9, 12-15, 22, and 23), the one or more limiting factors being pre-defined and selectable by user of the device prior to the processor processing the input *based on the search criteria* (pages 7, 9, 12-15, 17, and 22), the one or more limiting factors defining one or more processing characteristics relative to an optimal processing characteristic (i.e. per page 8 of the Applicant's specification, optimal or near optimal

output is based on the user input of ASAP versus take your time factors, and per Lexis, optimal processing can be achieved by selecting specific databases) of a recommendation generating process implemented in the recommender system, and to generate the recommendation *in accordance with the search criteria*, based at least in part on the input the stored profile associated with the device (i.e. inherent because Lexis limits certain kinds of access to features for students that it allows Professors to access based on who logs into Lexis) (page 1), the processing characteristic of the recommendation generating process being configured by the recommender system in accordance with the one or more limiting factors (pages 7, 8, 17, and 22) that limit the operating of the recommendation-generating process relative to the optimal processing characteristic (i.e. in Lexis, selecting the processing characteristic of a given jurisdiction on page 23 and pages 1-3 of the newly scanned pages attached with the OA, limits the generation of the recommendation to be from the database associated with that specific jurisdiction, since only those selected databases are operationally searched and billed to the user) (page 23 and pages 1-3 of the newly scanned pages attached with the OA).

9. In reference to claim 17, Lexis teaches a method for use in an information processing system for generating a recommendation at a processing device, the method comprising: *pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics (i.e. per page 8 of the Applicant's specification, optimal or near optimal output is based on the user input of ASAP versus take your time factors, and per Lexis, optimal processing can be achieved by selecting specific databases) of a recommendation-generating process implemented*

in the recommender system (i.e. giving the user the option to select the following Jurisdictions such as Federal Legal U.S., Federal and State case law, state court cases, MO Supreme Court and Court of Appeals Cases, MT Supreme Court Cases etc. (i.e. different databases can be searched) (pages 15 and pages 1-3 of the newly scanned pages included with this OA); receiving an input in a recommender system from a source separate from the processing device (i.e. from a user, a keyboard, or a mouse) (page 6), the recommender system carrying out or performing a recommendation-generating process (pages 7, 17, and 22); processing the input in the recommender system in accordance with the one or more pre-defined, user-selectable factors (page 15 and pages 1-3 of the newly scanned pages attached with this OA); generating an output recommendation based on the processed input (pages 7, 8, 17, and 22); and generating a ripeness indicator associated with the operation of the recommendation-generating process (i.e. per the Applicant specification on page 11 and Figure 7, the user would like to know how ripe is the recommendation as indicated by the ripeness indicator, and so the ripeness indicator indicates the ripeness of the recommendation result) as limited by the one or more pre-defined, user-selectable limiting factors (pages 3, 4, and 21-23).

10. In reference to claims 2, 13, and 16, Lexis teaches the method further including generating a ripeness indicator associated with the output recommendation, the ripeness indicator being indicative of the one or more user-selectable limiting factors (pages 3, 4, and 21-23).

11. In reference to claim 3, Lexis teaches the method wherein the ripeness indicator comprises a visual indicator having at least a first state corresponding to a first color and a second state corresponding to a second color (pages 3, 4, and 21-23).

12. In reference to claim 5, Lexis teaches the method wherein at least one of the user-selectable limiting factors is selectable via a user interface of the processing device (pages 2-5, 9, 11-15, 22, and 23).

13. In reference to claims 8 and 20, Lexis teaches the method wherein at least one of the user-selectable limiting factors comprises a specified limit on a quality measure associated with the output recommendation (i.e. all positive treatment and all negative treatment) (pages 4 and 12).

14. In reference to claim 9, Lexis teaches the method wherein at least one of the user-selectable limiting factors is selectable by the user as one of the plurality of points along a scale from a low level of the limiting factor to a high level of the limiting factor (i.e. one jurisdiction to all jurisdictions) (pages 12-14).

15. In reference to claim 10, Lexis teaches the method wherein the processing device is configured for presentation of the output recommendation in a visually perceptible manner on a display of the device (pages 1-17 and 21-23).

16. In reference to claim 12, Lexis teaches the method wherein the processing device comprises at least one of a desktop or portable personal computer (i.e. the Lexis site is accessed and utilized by using a computer) (pages 1-23), a personal digital assistant, wireless telephone and a set top box.

17. In reference to claim 21, Lexis teaches the method wherein the user-selectable limiting factors are predefined independent of receiving the input in the recommender system (i.e. sources such as state court cases, Federal and State case law, MO Supreme Court and Court of Appeals Cases, are predefined) (page 1 and 2 of the newly scanned pages) and further relate to resources used by the processing device to process the input in the recommender system (i.e. based on which database(s) is selected, such as state court cases, Federal and State case law, MO Supreme Court and Court of Appeals Cases, the processing device, processes the input in the recommender system by searching that selected database only) (pages 1-3 of the newly scanned pages).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 6, 7, 18, and 19 are rejected under U.S.C. 103(a) as being unpatentable over Lexis in view of Shaw ("Inventing the 'Paper' of Figure...Newspapers and the Future: First of Two Part. Next: Fax, phones, fear and the future." Los Angeles Times. June 2, 1991. Pages 1-8 hereinafter Shaw).

In reference to claims 6 and 18, Lexis does not does not teach the method wherein the limiting factor comprises a specified limit on an amount of time that may be

spent by the recommender system in generating the output recommendation. Shaw teaches the method wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation (Page 2 lines 33-34 and Page 3 lines 1-3). It would have been obvious to modify Lexis wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation to enable users to receive smaller or greater number of result listings which best match the user criteria according to how much time the user has available to view the search results.

19. In reference to claims 7 and 19, Lexis does not does not teach the method wherein the limiting factor comprises a specified limit on an amount of power consumption utilized (this is also considered to be equal to the amount of time that may be spent by the recommender system in generating the output recommendation, since in effect if you are running out of power, you are running out of the amount of time you have available to access the device prior to shut down as a result of depleting the power supply) in conjunction with generating the output recommendation. Shaw teaches the method wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation (Page 2 lines 33-34 and Page 3 lines 1-3). It would have been obvious to modify Lexis wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation to enable users to receive smaller or greater number of result listings which best match the user

criteria according to how much time the user has available to view the search results.

20. Claims 4 and 11 are rejected under U.S.C. 103(a) as being unpatentable over Lexis in view of Official Notice.

In reference to claims 4 and 11, Lexis teaches the method comprising of a visual ripeness indicator (pages 3, 4, and 21-23). Lexis does not teach the ripeness indicator to be audible and presenting the information using a speaker associated with the device. In reference to claim 4, Official Notice is taken that it is old and well known to use an audible indicator to indicate the existence and degree of a match in the case of an announcement of winning lottery numbers or bingo numbers for example and to play this information using computer speakers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of an audio indicator in the ripeness indicator and computer speakers to enable users to audibly determine the degree of match of the results in relation to a given criteria, since some people may want to receive this information by the use of audio and others may prefer to view the information graphically.

Response to Arguments

21. After careful review of Applicant's remarks/arguments filed on 07/07/08, the Applicant's arguments with respect to claims 1-14 and 16-21 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

22. Applicant argues that Lexis does not teach a recommender system that limits optimal processing characteristics in accordance with one or more user-selectable

limiting factors. While the Examiner agrees that some of the factors disclosed in Lexis such as KWIC search etc are limiting the results after the results have already been processed, other factors in Lexis regarding Jurisdiction selections, are done prior to conducting a search in a database and may be done later as well. For example, newly scanned and included pages 1-3 with this OA, highlight that a user can select sources such as state court cases, Federal and State case law, MO Supreme Court and Court of Appeals Cases, and only the selected source databases will be searched for the user provided query. And, these are therefore clearly optimal processing characteristics of a recommendation generating process that pertain to the operation of the device to search specific databases to produce the results and not to simply the presentation of the results in a particular manner.

See Figures 1-3 below that were also provided in the previous OA.

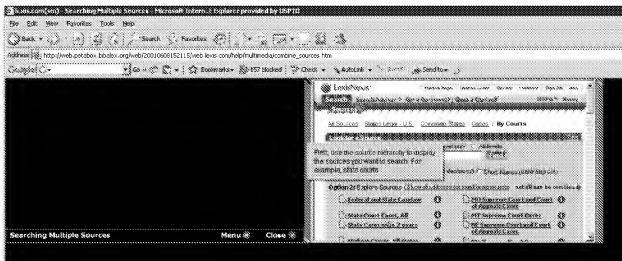


Figure 1

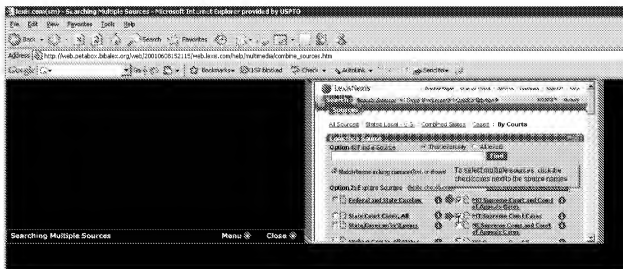


Figure 2

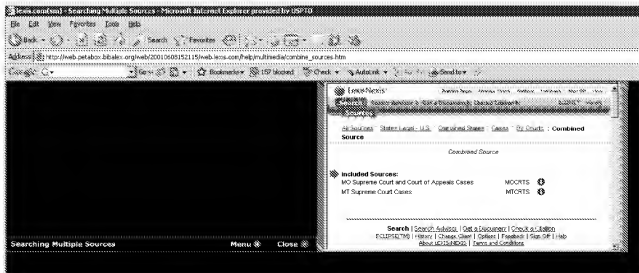


Figure 3

23. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is

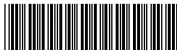
571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622

Application Number**Application/Control No.**

09/902,407

**Applicant(s)/Patent under
Reexamination**

ALSAFADI ET AL.

Examiner

NAMRATA BOVEJA

Art Unit

3622